



*Patricia Lewis*  
D-1113  
#7/Brief  
Appeal  
9-16-02  
r/lee

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	)	
Jeffery M. Enright	)	
	)	
Serial No.: 09/439,718	)	Art Unit 3622
	)	
Confirm. No.: 2011	)	
	)	
Filed: November 12, 1999	)	Patent Examiner
	)	Donald L. Champagne
Title: Cash Dispensing Method for	)	
Self-Service Facility such as	)	
Motor Fuel Dispensing Facility	)	

Board of Patent Appeals and Interferences  
Commissioner for Patents  
Washington, D.C. 20231

RECEIVED  
SEP 16 2002  
GROUP 3000

BRIEF OF APPELLANT PURSUANT TO 37 C.F.R. § 1.192

Sir:

The Appellant hereby submits the Brief pursuant to 37 C.F.R. § 1.192, in triplicate,  
concerning the above-referenced Application.

09/12/2002 SSITHIB1 00000122 090428 09439718

01 FC:120 320.00 CH

OK

copy 1/3

## **REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

## **RELATED APPEALS AND INTERFERENCES**

Appellant believes that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-43 are pending in the Application.

Claims 38-39 were rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by Phillips et al. (hereinafter "Phillips").

Claims 1-37 and 40-43 were rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Phillips in view of Gatto.

These rejections were the only rejections present in the Office Action ("Action") dated May 8, 2002, which was made Final. Appellant appeals the rejections of the claims, inclusive.

## **STATUS OF AMENDMENTS**

A final rejection was made May 8, 2002. No amendments to the claims were requested to be admitted after the final rejection.

## **SUMMARY OF INVENTION**

### **Overview of the Invention**

An exemplary embodiment of the present invention is directed to a method of providing cash to a customer. A self-service dispensing machine (12; Figure 1) (e.g., a motor fuel dispensing device including a fuel pump control console) is able to receive customer requests for both merchandise (e.g., fuel) and a cash withdrawal. A single payment (e.g., credit card) can be made by the customer at the machine for both the fuel and the cash withdrawal request. The machine may be able to provide a code to the customer regarding the cash withdrawal request. The customer is then able to use the code to receive the requested cash from a self-service automated cash dispensing device (28) (e.g., an ATM). Information regarding the cash withdrawal request can be communicated from the self-service dispensing machine to the self-service automated cash dispensing device (28). The cash dispensing device (28) can be located in a customer service facility (14) remote from the self-service dispensing machine (12). The customer, with the received cash, can make a cash purchase for additional merchandise (18) at the facility. Alternative exemplary forms of the invention are further discussed in the Specification.

## **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are:

- 1). Whether Appellant's claims 38-39 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Phillips.
- 2). Whether Appellant's claims 1-37 and 40-43 are unpatentable under 35 U.S.C. § 103(a) over Phillips in view of Gatto.

### **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Every claim recites additional features of the invention which distinguishes the claim over every other pending claim.

Each of Appellant's claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include three independent claims (claims 1, 38, and 40). Claims 2-37 depend from claim 1. Claim 39 depends from claim 38. Claims 41-43 depend from claim 40. All pending claims 1-43 are reproduced in the Appendix.

### **ARGUMENT**

#### **The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of

obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

### **The Phillips Reference**

Phillips is directed to vending goods in conjunction with a credit card accepting fuel dispensing pump. A vending machine (3) is located adjacent a gas pump (1) on a pump island (col. 2, line 62 to col. 3, line 7; Figure 3). The vending machine (3) is for vending goods such as canned drinks (col. 6, lines 36-41). A customer is prompted at the gas pump to purchase a canned drink (col. 10, lines 50-61). An object of Phillips is to locate the vending machine (3) adjacent the gas pump (1) so that a customer is able to purchase goods from the vending machine via the same credit card transaction as is used with the fuel pump (col. 3, lines 13-21). A code is generated at the gas pump. The code can then be entered by the customer into the vending machine to obtain the purchased canned drink without the need of cash in the transaction (e.g.,

col. 3, lines 19-21; col. 24 lines 17-20). The location of the vending machine conveniently permits a customer to drink a purchased drink while pumping gas (col. 26, lines 46-49).

### **The Gatto Reference**

Gatto is directed to a fuel pump system with automated transaction processing. Customized purchaser-defined plural fuel pump transactions, including transaction parameters that define each transaction, are stored on a purchaser's card (col. 3, lines 8-23). The transaction parameters may include form of payment, grade of fuel, and whether a receipt should be printed (col. 3, lines 24-33). Subsequent fuel pump operation can be simplified by enabling the purchaser to enter a single input to select the desired transaction.

### **(iii) 35 U.S.C. § 102**

Phillips does not teach each and every feature, relationship, and step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Thus, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections should be withdrawn.

### **The Pending Claims Are Not Anticipated By Phillips**

In the Action claims 38-39 were rejected under 35 U.S.C. § 102(e) as being anticipated by Phillips. These rejections are respectfully traversed.

The Action alleges (with regard to claim 38) that Phillips teaches steps (a) accepting an amount of cash for the merchandise (col. 27, lines 22-39); (b) generating a code for the amount

of change (col. 3, lines 13-22); (c) outputting the code on a receipt; and (d) paying a second charge by inputting the code (col. 3, lines 41-42). The Action further alleges (with regard to claim 39) that the receipt reads on indicia representative of the code. The Appellant respectfully disagrees.

### **Claim 38**

Phillips does not teach the recited features and relationships. For example, Phillips does not teach "generating a code" which corresponds to a difference between a merchandise charge and an amount of cash accepted.

There is no indication that Phillips' fuel dispenser permits accepting cash. Nor is there any indication that Phillips' fuel dispenser can constitute the recited "first" dispensing machine. The Action relies on col. 27, lines 22-39 of Phillips for the vending machine (3) as a cash accepting device in the alleged teaching of step (a). However, even if Phillips' vending machine permitted accepting cash, there isn't any specific teaching that Phillips generates a code which "corresponds to an amount of change" (step b) from the vending machine. Phillips does not generate a code with regard to the difference between a first charge and the amount of cash accepted with the vending machine. Where does Phillips specifically teach generating a code with regard to vending machine change, especially change from "paying" with cash "for merchandise delivered" (step a)?

Furthermore, if Phillips' vending machine is alleged as the recited "first" dispensing machine (because of the alleged cash acceptance) then it follows that Phillips' fuel dispenser must be alleged as the recited "second" dispensing machine. However, step (d) recites "paying



for a second charge for merchandise delivered to the user at a second self service dispensing machine, including inputting the code and reducing the second charge by the amount of change that corresponds to the code." There isn't any specific teaching in Phillips that a generated code is used to pay "for merchandise delivered" at the fuel dispenser (the alleged second dispensing machine).

Where does Phillips specifically teach paying for first merchandise (at a first dispensing machine) with cash, generating a code corresponding to the change, and paying for second merchandise (at a second dispensing machine) using the code? Phillips does not teach the recited steps. It follows that Phillips cannot anticipate the claim. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection should be withdrawn.

**Claim 39**

Claim 38 has been previously shown to be allowable. It is asserted that claim 39, which depends from claim 38, is allowable on the same basis. Furthermore, claim 39 additionally recites specific steps, features, and relationships that patentably distinguish the claimed invention over Phillips. Phillips does not teach the further recited features of the outputting step and the second charge paying step. Thus, it is respectfully submitted that the 35 U.S.C. § 102(e) rejection should be withdrawn.

**(iv) 35 U.S.C. § 103**

The attempts to combine the teachings of the references are clearly attempts at hindsight reconstruction of Appellant's claimed invention, which is legally impermissible and does not

constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellant's disclosure. It follows that it would not have been obvious to have modified the references in the manner alleged. Furthermore, without a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

Appellant traverses the rejections on the grounds that Appellant's claims recite features, relationships, and steps which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellant's invention. The features, relationships, and/or steps recited in Appellant's claims patentably distinguish over the applied reference(s). Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of the references to have produced the recited invention.

The Office does not factually support any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness, the prior art must teach or suggest all the claim limitations. If the Office does not produce a *prima facie* case, then the Appellant is under no obligation to submit evidence of nonobviousness (MPEP § 2142). The Office has not presented a *prima facie* showing of obviousness. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections are improper and should be withdrawn.

**The Pending Claims Are Not Obvious Over  
Phillips in view of Gatto**

In the Action claims 1-37 and 40-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Phillips in view of Gatto. These rejections are respectfully traversed.

**Claim 1**

The Appellant respectfully disagrees with the Action's interpretation of Phillips. Phillips does not teach or suggest a user input that corresponds to a request for an amount of cash (e.g., step b); charging a source of monetary value for both a merchandise charge and the requested cash amount (e.g., step c); communicating information representative of the cash request to a facility remote from the machine (e.g., step d); or delivering the requested amount of cash to the user after the user arrives at the facility (e.g., step e).

Even the Action admits (numbered paragraph 8) that Phillips does not teach or suggest having a facility (including a supply of cash) remote from a self-service dispensing machine. The Action further admits (e.g., numbered paragraph 13) that Phillips does not teach or suggest requesting an amount of cash, charging for the amount of requested cash, or delivering the amount of cash.

The Action alleges that it would have been obvious to have placed Phillips' second goods dispensing apparatus in the mini-market facility. The Appellant disagrees.

As admitted in the Action (e.g., numbered paragraph 13), Phillips' second goods dispensing apparatus is not associated with cash dispensing. Phillips' second goods dispensing apparatus is associated with a vending machine (3) for vending canned drinks (col. 3, lines 1-7).

The vending machine (3) is located "on a pump island of a vehicle fueling facility (col. 2, lines 62-67)." The vending machine (3) does not dispense requested cash, especially requested cash corresponding to a cash request input. Therefore, even if it were somehow possible (which it isn't) to have placed Phillips' pump island vending machine (3) in a mini-market facility it still would not have dispensed requested cash.

Furthermore, it would not have been obvious to have located Phillips' second goods dispensing apparatus (i.e., vending machine) at a facility remote from the pump island. Phillips provides no teaching, suggestion, or motivation for (remotely) locating the vending machine (3) inside of a mini-market. On the contrary, Phillips teaches that his invention solves the prior art problems by locating the vending machine "on a pump island" of a vehicle fueling facility (col. 2, lines 62-67; col. 7, lines 32-35). The vending machine (3) is "proximate to a self serve fuel dispensing pump 1" (col. 3, lines 15-16; Figure 3). Additionally, Phillips desires that the vending machine be close to the fuel pump so that a user is able to purchase and drink a soft drink while pumping gas (col. 26, lines 46-49). That is, Phillips specifically teaches locating the vending product near the user at the pump island.

Furthermore, it would not have been obvious to have placed Phillips' vending machine inside of a mini-market, as the Action has alleged. One skilled in the art would recognize that it would not have been obvious for a user in Phillips to leave the fuel pump island (and leave their vehicle and seated small children therein) to go inside a mini-market to use a vending machine when they can purchase the same item at the island (and without the need of cash). Nor would one skilled in the art look to use a vending machine inside a mini-market when they can purchase

the same item (and other items) at the checkout counter. Nor would it be obvious to locate a vending machine in a space-limited mini-market where the owner may be prevented from marking up the price of the item vended. Thus, it would not have been obvious to have placed Phillips' second goods dispensing apparatus in a mini-market facility.

Furthermore, even if it were somehow possible for Phillips' second goods dispensing apparatus (i.e., vending machine) to dispense cash (which it isn't), then it still would not have been obvious to have placed the pump island dispensing apparatus in a mini-market facility, as previously discussed.

The Action admits (numbered paragraph 10) that Phillips teaches, as the solution, locating a vending machine on the fuel pump island. Nevertheless, the Action, against the direct teaching of Phillips, and the Action's own admission of Phillips' indicated solution, alleges (page 4, lines 1-2) that it would have been obvious "to use the mini-market itself as the venue for retailing the second goods." The Appellant respectfully disagrees. Additionally, it is unclear how using the mini-market itself as the venue for retailing the second goods alleviates the admitted absence in Phillips of requesting an amount of cash, charging for the amount of requested cash, and delivering the amount of cash.

Furthermore, the alleged modification to Phillips would destroy the disclosed and desired utility or operability of the Phillips teaching. An obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. Note *In re Fine*, 5 USPQ2d 1598-99

(Fed. Cir. 1988). Therefore, it would not have been obvious to have modified Phillips as alleged (in direct conflict with Phillips' teaching) to have produced Appellant's recited invention.

Gatto cannot overcome the admitted deficiencies of Phillips as it does not disclose or suggest the recited features which are not found in Phillips. The Action is silent as to the relied upon teachings of Gatto. The Action is also silent as to how Phillips could be modified by Gatto to include the recited features and relationships. The Action is devoid of any such teaching, suggestion, or motivation for combining the references. Neither Phillips nor Gatto, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claim.

Gatto, being similar to Phillips, is limited to transactions adjacent a fuel pump. The Action admits (numbered paragraph 8) that Phillips does not teach or suggest having a facility (including a supply of cash) remote from a self-service dispensing machine. Gatto is also not concerned with a facility remote from a self-service dispensing machine. Gatto does not teach or suggest having a facility (including a supply of cash) remote from the fuel pump. Nor is Gatto concerned with delivering a requested amount of cash at a facility remote from the fuel dispenser. Nor does Gatto disclose or suggest receiving a cash request input adjacent the fuel dispenser and delivering the requested cash at a facility remote from the fuel dispenser.

Nor does Phillips or Gatto teach or suggest delivering a requested amount of cash to the user after the user arrives at a facility which is remote from the dispensing machine.

Neither Phillips nor Gatto discloses or suggests a link between their fuel dispenser and a facility (having a cash supply) remote from the dispenser. Neither Phillips nor Gatto discloses or

suggests delivering information representing a cash request to a facility remote from their dispenser. Nor has the Action presented any factual evidence that it was known in the prior art to request cash adjacent a self-service dispensing machine, charge for the amount of requested cash, and deliver the requested cash to a user at a facility remote from the dispensing machine.

The Action alleges (numbered paragraph 12) that Gatto's mentioning of "pay inside" and "cash back" is directed to delivering a requested amount of cash remote from the fuel pump. The Appellant respectfully disagrees.

If a user of the Gatto system chooses "pay inside" then by definition there is no payment at the pump (col. 1, lines 26-33). Nor would Gatto's "pay inside" be pertinent to the recited invention. For example, there would be no payment in Gatto at a self-service dispensing machine, nor would a user in Gatto have the capability of inputting a request for a cash amount adjacent the machine.

Gatto has a dispenser (19) "for dispensing currency for change or cash back" (col 6, lines 25-26). However, there is no teaching or suggestion in Gatto that the "cash back" corresponds to an "input" which "corresponds to a request for an amount of cash" (step b). Contrarily, it would appear that the "cash back" refers to a refund of an unintentional over payment for fuel, not to a user inputted request for an amount of cash. For example, the dollar amount of fuel to be purchased is one of the predetermined transaction parameters. If a user did not use the entire (paid for) dollar amount of fuel then a "cash back" refund would be dispensed. The refund would be based on the gallons of gas pumped, not on a user's input request for an amount of cash. Gatto, like Phillips, does not teach or suggest the step of "receiving" a cash request "input" from

the user "through an input device" adjacent the fuel dispenser, especially where the user input corresponds to a request for an amount of cash.

Furthermore, Gatto's dispenser (19) is located at the fuel pump (Figure 3). Thus, even if it were somehow possible for a user in Gatto to input a request for an "amount" of cash at the fuel pump, the cash would not be delivered to a user at a facility remote from the fuel pump.

The Action also alleges (numbered paragraph 14) by inherency that Gatto's "cash back" would require a cash register in a mini-market, and the cash register reads on a remote cash dispensing device. The Appellant respectfully disagrees. The Action is silent as to where Gatto is associated with a mini-market. The Action is also silent as to where Gatto's "cash back" requires a cash register in a mini-market. On the contrary, Gatto teaches that the dispenser (19) is located at the fuel pump and is "for dispensing currency for change or cash back" (col 6, lines 25-26). That is, any change or refund due would be at the fuel pump, not at a cash register in a mini-market. It follows that Gatto does not "require" (or need) a cash register in a mini-market. Gatto also does not teach or suggest the recited step of communicating information involving a remote facility.

As previously discussed, both Phillips and Gatto are limited to transactions adjacent a fuel pump. Gatto cannot alleviate the deficiencies in Phillips. Thus, even if it were somehow possible to combine Phillips with Gatto's teachings (which it isn't) the resultant combination still would not have produced the recited invention. The combination, if somehow possible, would at best have resulted in a modified Phillips including the ability of a gasoline purchaser to enter a single input to select a customized purchaser-defined fuel pump transaction. However, as



previously discussed, the resultant combination would still lack the features and relationships recited in Appellant's claim. For example, the resultant combination would still not be concerned with delivering a requested amount of cash at a facility remote from the fuel dispenser.

Furthermore, even if it were somehow possible to combine Phillips with Gatto's teaching, this would not render the resultant combination obvious because the desirability of the combination is not suggested (MPEP § 2143.01).

The attempts to modify Phillips are clearly attempts at hindsight reconstruction of Appellant's claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellant's disclosure.

The Office has not presented a *prima facie* showing of obviousness. If the Office does not produce a *prima facie* case, which is the current situation, then Appellant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Nevertheless, Appellant has shown that neither Phillips nor Gatto discloses or suggests the recited steps, features, and relationships. Nor would it have been obvious to have combined the teachings of Phillips and Gatto. Nor would it have been obvious to have combined the teachings of Phillips and Gatto to have produced Appellant's recited invention. Furthermore, Appellant has also shown that even if it were somehow possible for Phillips to include the teachings of Gatto, the modified Phillips would still lack the recited steps, features, and relationships. It follows that neither Phillips nor Gatto, taken alone or in combination, discloses

or suggests the steps, features, and relationships that are specifically recited in the claim. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn.

The Appellant respectfully submits that each of the claims which depend directly or indirectly from independent claim 1 are allowable on the same basis. Furthermore, each of these dependent claims additionally recites at least one specific feature, relationship, or step that patentably distinguishes the claimed invention over the applied art. Thus, it is respectfully submitted that dependent claims 2-37 are further allowable due to the recitation of such additional features, relationships, or steps.

#### **Claim 2**

Claim 2 depends from claim 1. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests reducing the amount of cash delivered to a user at a remote facility by the cost associated with other merchandise in the manner recited. Nor would it have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced the claimed invention. Nor has the Office established a *prima facie* showing of obviousness.

#### **Claim 3**

Neither of the applied references, taken alone or in combination, discloses or suggests receiving payment of merchandise cost from the user in cash at the remote facility in the manner recited. Thus, it would not have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

#### **Claim 4**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests receiving an item from the user at the facility in exchange for the amount of cash in the manner recited. Nor has the Office established a *prima facie* showing of obviousness.

#### **Claim 5**

Claim 5 depends from claim 4. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests receiving a printed item from the user at the facility in exchange for the amount of cash. Nor would it have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

#### **Claim 6**

Claim 6 depends from claim 4. Neither of the applied references, taken alone or in combination, discloses or suggests reading machine readable indicia with a reading device at a facility (remote from the dispensing machine). The Office has not established a *prima facie* showing of obviousness.

#### **Claim 7**

Claim 7 depends from claim 6. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests dispensing an amount of cash from a cash dispensing mechanism responsive to reading an item with a reading device at a facility (remote from the machine). The Action (numbered paragraph 17) alleges that Phillips teaches the recited features. However, it is unclear how Phillips can be relied upon for the recited features when the Action admits (numbered paragraph 14) that Phillips does not teach or suggest a cash dispensing device remote

from the customer request station. It follows that the Office has not established a *prima facie* showing of obviousness.

#### **Claim 8**

Claim 8 depends from claim 7. Neither of the applied references, taken alone or in combination, discloses or suggests a supply having a separate portion, and loading cash from separate portion to the cash dispensing mechanism. Nor would it have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced the claimed invention. Nor has the Office established a *prima facie* showing of obviousness.

#### **Claim 9**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests communicating information representative of a cash request to a facility remote from the machine, including providing a visual indication through an output device that the user has requested the amount. Again, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 10**

Neither of the applied references, taken alone or in combination, discloses or suggests a total being equal to the charge and the requested amount in the manner recited. Nor would it have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

### **Claim 11**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests using a communications network in the manner recited. It follows that the Office has not presented a *prima facie* showing of obviousness.

### **Claim 12**

Neither of the applied references, taken alone or in combination, discloses or suggests paying a charge for motor fuel in the manner recited. The Office has not established a *prima facie* showing of obviousness.

### **Claims 13-15**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests a machine readable article including a credit card (claim 13), a debit card (claim 14), or a stored value card (claim 15) in the manner recited. Nor do the applied references teach or suggest charging a source of monetary value for both a merchandise charge and a requested amount of cash, where the article corresponds to the source of monetary value. Nor would it have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

### **Claim 16**

Claim 16 depends from claim 15. Neither of the applied references, taken alone or in combination, discloses or suggests modifying data stored in the stored value memory of a stored value card in the manner recited. Where does Phillips or Gatto teach or suggest modifying data stored in a stored value memory of a stored value card? The Office established a *prima facie* showing of obviousness.

### **Claim 17**

Claim 17 depends from claim 15. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests loading data representative of a further amount of monetary value to the stored value card, and charging the further amount to the source of the monetary value in the manner recited. The Action (numbered paragraph 18) admits that Phillips does not teach or suggest the recited features. The Action (numbered paragraph 18) alleges that Gatto teaches the recited features. However, the Action is silent as to where Gatto teaches the recited features. Nor does Gatto teach the recited features. It follows that the Office has not presented a *prima facie* showing of obviousness.

### **Claim 18**

Neither of the applied references, taken alone or in combination, discloses or suggests delivering an amount of cash to a user responsive to the user delivering an item (delivered to the user at the dispensing machine in response to a cash request) to the facility. It follows that it would not have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

### **Claim 19**

Claim 19 depends from claim 18. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests delivering an amount of cash to a user responsive to the user delivering a printed document (delivered to the user at the dispensing machine in response to a cash request) to the facility. Nor has the Office established a *prima facie* showing of obviousness.

### **Claim 20**

Neither of the applied references, taken alone or in combination, discloses or suggests receiving an input corresponding to a request for an amount of cash, wherein the input corresponds to the user touching at least one key. As previously discussed, the Action is devoid of a teaching or suggestion of having a cash request input received and an amount of cash delivered in the manner recited. It follows that using a key for the cash request input is also not taught or suggested by either reference. Again, the Office has not established a *prima facie* showing of obviousness.

### **Claim 21**

Claim 21 depends from claim 20. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests a prompt message advising a user to press at least one of the keys if they wish to receive an amount of cash. Nor does either reference disclose or suggest delivering the amount of cash to the user after the user arrives at a remote facility. Nor it would it have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

### **Claim 22**

Neither of the applied references, taken alone or in combination, discloses or suggests delivering the cash to a user after the user arrives at a facility remote from the dispensing machine. It follows that neither reference discloses nor suggests reviewing identification associated with the user at the facility prior to delivering the cash. The Office has not established a *prima facie* showing of obviousness.

### **Claim 23**

Claim 23 depends from claim 22. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests reviewing the machine readable article (used in step a), reviewing a driver's license associated with the user, or receiving a biometric input from the user. Again, the Office has not established a *prima facie* showing of obviousness.

### **Claim 24**

Neither of the applied references, taken alone or in combination, discloses or suggests delivering cash (which was requested adjacent a motor fuel dispensing machine) to a user in an indoor sales area remote from the motor fuel dispensing machine. It follows that it would not have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

### **Claim 25**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests delivering cash (which was requested adjacent a motor fuel dispensing machine) to a user through a facility service window remote from the motor fuel dispensing machine. It follows that it would not have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

Appellant respectfully disagrees with the Action's assertion of Official notice (numbered paragraph 19). Appellant previously (in Response filed March 7, 2002) respectfully traversed the Official notice assertions on the basis that they are not supported by any reference to prior art. The Office is not permitted to rely merely on assertions of Official notice as the basis for



rejecting claims. Appellant previously challenged all rejections based upon alleged Official notice and required the Office to support a rejection of the features and relationships recited in the claim with citation to relevant prior art as required by MPEP § 2143.03 and 2144.03. When challenged the Office was required to establish such assertions in the proper manner through citation to prior art. The Office had ample opportunity to furnish supporting evidence. However, the Action has provided no citation to prior art supporting the assertions of any Official notice. Thus, in the absence of an express showing of the asserted teachings in the prior art, the rejection is improper and should be withdrawn.

**Claim 26**

Claim 26 depends from claim 25. Neither of the applied references, taken alone or in combination, discloses or suggests moving a vehicle from adjacent a motor fuel dispensing machine to adjacent a drive-up service window prior to delivering requested cash to the user. Again, the Office has not established a *prima facie* showing of obviousness.

**Claim 27**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests an apparatus operating to perform the recited steps a, b, c, d, and e. Thus, the Office has not established a *prima facie* showing of obviousness.

**Claim 28**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests dispensing requested cash from a cash dispensing device at a remote facility responsive to reading (with a reading device) machine readable indicia (which was provided to the user

adjacent a self-service dispensing machine responsive to a request for the cash amount). It follows that it would not have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

#### **Claim 29**

Claim 29 depends from claim 28. Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests dispensing requested cash from a cash dispensing device at a remote facility responsive to reading (with a reading device) machine readable indicia printed on a paper item (which was provided to the user adjacent a self-service dispensing machine responsive to a request for the cash amount). Again, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 30**

Neither Phillips nor Gatto discloses or suggests providing a user with a code at the self service dispensing machine responsive to a request for a cash amount. Neither Phillips nor Gatto discloses or suggests receiving input of the code through an input device at a facility remote from the self service dispensing machine. It follows that neither Phillips nor Gatto, taken alone or in combination, discloses or suggests dispensing the requested cash from a cash dispensing device responsive to receiving input of the code through the input device. It further follows that the Office has not established a *prima facie* showing of obviousness.

#### **Claim 31**

Claim 31 depends from claim 30. Furthermore, neither Phillips nor Gatto discloses or suggests providing a user with the code printed on a paper item at a self service dispensing

machine responsive to a request for a cash amount, and dispensing the requested cash from a cash dispensing device responsive to receiving input of the code. Again, the Office has not established a *prima facie* showing of obviousness.

### **Claim 32**

Claim 32 depends from claim 30. Furthermore, neither Phillips nor Gatto discloses or suggests providing a user with the code printed on a receipt at a self service dispensing machine responsive to a request for a cash amount, and dispensing the requested cash from a cash dispensing device responsive to receiving input of the code. It follows that the Office has not established a *prima facie* showing of obviousness.

### **Claim 33**

Neither Phillips nor Gatto discloses or suggests receiving a further input corresponding to the user through a further input device adjacent a self-service dispensing machine. Neither Phillips nor Gatto discloses or suggests correlating through operation of a computer, data corresponding to the further input and the amount. Neither Phillips nor Gatto discloses or suggests receiving the further input through a remote input device at a remote facility. It follows that neither Phillips nor Gatto, taken alone or in combination, discloses or suggests dispensing the amount of cash from a cash dispensing device responsive to receipt of the further input through the remote input device. It further follows that it would not have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

#### **Claim 34**

Claim 34 depends from claim 33. Furthermore, neither Phillips nor Gatto discloses or suggests that the further input includes a user selected code in the manner recited. Hence, the Office has not established a *prima facie* showing of obviousness.

#### **Claim 35**

Claim 35 depends from claim 33. Furthermore, neither Phillips nor Gatto discloses or suggests that the further input corresponds to at least one feature of the user and the further input device includes a biometric input device. Where does Phillips or Gatto teach or suggest a biometric input device? The Office has not established a *prima facie* case of obviousness.

#### **Claim 36**

Claim 36 depends from claim 33. Furthermore, neither Phillips nor Gatto discloses or suggests that the further input corresponds to at least one feature of a vehicle operated by the user. The Office has not established a *prima facie* showing of obviousness.

Appellant respectfully disagrees with the Action's assertion of Official notice (numbered paragraph 19). Appellant previously respectfully traversed (challenged) the Official notice assertion on the basis that it is not supported by reference to any prior art. The Office was required to establish such assertions in the proper manner through citation to relevant prior art as required by MPEP § 2143.03 and 2144.03. However, the Action has provided no citation to prior art supporting the assertions of Official notice. In the absence of an express showing of the asserted teachings in the prior art, the rejection is improper and should be withdrawn.

### **Claim 37**

Neither Phillips nor Gatto, taken alone or in combination, discloses or suggests dispensing the amount of cash from a cash dispensing device responsive to reading the machine readable article with an input device at the remote facility. Where does Phillips or Gatto disclose or suggest reading a machine readable article for paying for merchandise (step a) and reading the machine readable article at a remote facility for dispensing the requested cash? It follows that it would not have been obvious to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

### **Claim 40**

Claim 40 is an independent method claim. Claim 40 recites some subject matter similar to subject matter in claim 1. Appellant's remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. It is respectfully submitted that claim 40 also patentably distinguishes over the applied references. Neither Phillips nor Gatto, taken alone or in combination, disclose or suggest the steps, features, and relationships that are specifically recited in claim 40. The Office has not presented a *prima facie* showing of obviousness. Thus, the 35 U.S.C. § 103(a) rejection should be withdrawn.

Neither Phillips nor Gatto teaches or suggests providing a code (at a customer request station) responsive to an input request (at the customer request station) corresponding to an amount of cash.

Additionally, as previously discussed, both Phillips and Gatto are limited to transactions adjacent a fuel pump. Neither Phillips nor Gatto teaches or suggests delivering requested cash

from a cash dispensing device at a cash delivery station responsive to receiving input of a code at the cash delivery station, especially where the cash delivery station is remote from the customer request station (where the cash request input was received and where the code was provided). Nor does either reference teach or suggest that the cash delivery is subsequent to customer arrival at the cash delivery station. Thus, it would not have been obvious to have combined the teachings of Phillips and Gatto to have produced Appellant's recited invention.

The Action admits (numbered paragraph 14) that Phillips does not teach or suggest a cash dispensing device remote from the customer request station. The Action apparently alleges (numbered paragraph 14) that Gatto, under the principle of inherency, anticipates the recited method. The Action further alleges that Gatto's "pay inside" and "cash back" would require a cash register in a mini-market, and that the cash register would read on a remote cash dispensing device. The Appellant respectfully disagrees.

As previously discussed, the Action is silent as to where Gatto is associated with a mini-market. The Action is also silent as to where Gatto's "cash back" requires a cash register in a mini-market. On the contrary, Gatto teaches that the dispenser (19) is located at the fuel pump and is "for dispensing currency for change or cash back" (col 6, lines 25-26). That is, any change or refund due would be at the fuel pump, not at a cash register in a mini-market. It follows that Gatto does not "require" (or need) a cash register in a mini-market. It also follows that Gatto does not teach or suggest delivering requested cash at a cash delivery station, which is remote from a customer request station (where a code is provided), responsive to receiving input of the code at the cash delivery station.

Gatto does not anticipate the recited method as alleged. Inherency may not be established based on probabilities or possibilities. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. *In re Robertson*, supra. It is unclear how the Office can allege inherency in Gatto when the reference specifically teaches that it is the dispenser (19), which is located at the fuel pump, that dispenses the currency for change or cash back.

As previously discussed, the Action admits (numbered paragraph 14) that Phillips does not teach or suggest a cash dispensing device remote from a customer request station. It follows that neither Phillips nor Gatto teaches or suggests a cash dispensing device remote from a customer request station in the manner recited. It further follows that even if it were somehow possible for Phillips to include the teachings of Gatto, the modified Phillips would still lack the relationships involving a customer request station, cash request, code, and cash dispensing device at a cash delivery station.

Appellant has shown that neither Phillips nor Gatto discloses or suggests the recited steps, features, and relationships. Nor would it have been obvious to have combined the teachings of Phillips and Gatto. Nor would it have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced Appellant's recited invention. Furthermore, Appellant has also shown that even if it were somehow possible for Phillips to include the teachings of Gatto, the modified Phillips would still lack the recited steps, features, and relationships. It follows that neither Phillips nor Gatto, taken alone or in combination, discloses or suggests the steps, features, and relationships that are specifically

recited in the claim. Nor has the Office established a *prima facie* showing of obviousness. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection should be withdrawn.

**Claim 41**

Claim 41 depends from claim 40. Neither Phillips nor Gatto, taken alone or in combination, disclose or suggest receiving a request for fuel in the manner recited. Nor would it have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced the claimed invention. The Office has not established a *prima facie* case of obviousness.

**Claim 42**

Claim 42 depends from claim 40. Neither of the applied references, taken alone or in combination, disclose or suggest dispensing cash from a self-service automated cash dispensing device (remote from a customer request station) responsive to receiving input of the code at the cash dispensing device in the manner recited. Nor would it have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

The Action admits (numbered paragraph 20) that neither Phillips nor Gatto discloses or suggests a self-service automated cash dispensing device. Furthermore, even if Gatto did teach a dispensing device "near the fuel pump" as alleged, the device would still not be remote from the fuel pump. It follows that the Office has not presented a *prima facie* showing of obviousness.



**Claim 43**


Claim 43 depends from claim 42. Neither Phillips nor Gatto, taken alone or in combination, disclose or suggest dispensing cash from an ATM responsive to receiving a code in the manner recited. Nor would it have been obvious to one having ordinary skill in the art to have modified Phillips with the teachings of Gatto to have produced the claimed invention.

The Action admits (numbered paragraph 20) that neither Phillips nor Gatto discloses or suggests an ATM. Furthermore, even if Gatto did teach a dispensing device "near the fuel pump" as alleged, the device would still not be an ATM remote from the fuel pump. It follows that the Office has not produced a *prima facie* case of obviousness.

**CONCLUSION**

Each of Appellant's pending claims specifically recites features, relationships, and steps that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

  
\_\_\_\_\_  
Ralph E. Jocke  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000

Reg. No. 31,029